

REMARKS

I. Claim Status

Claims 1-20 are pending in the application and stand rejected. The previously made restriction requirement has been withdrawn. Claims 1-8 have been rejected under 35 U.S.C. § 112. Claims 1-20 have been rejected under 35 U.S.C. § 103.

II. Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-8 have been rejected under 35 U.S.C. § 112, second paragraph as indefinite. The Office Action maintains that the recitation of the variable "Z" as the thickness of the substrate as claimed in claim 1 is vague. The Office Action also seems to state that a thickness of zero is also being claimed, rendering the claim vague.

The Office Action has not demonstrated that the language of Claim 1 would be unclear to one of ordinary skill in the art. The claim merely states the substrate has a thickness and designates this thickness as "Z" for ease of referring to it later in the claim. The Office Action points to nothing which would render the concept of a substrate's thickness unclear. The fact that the specification also defines a "z" direction (as being in the same direction as the thickness of an article) does not make this claim language unclear. Indeed, on page 3, lines 10-18, the "Z-direction" is expressly defined, and the specification expressly notes that this direction is a convenient means for specifying the thickness of the article. The Office Action provides no explanation as to why this is unclear.

Regarding the concern that the thickness can be zero, a closer reading of Claim 1 reveals that this is not the case. $Z=0$ is simply the definition of one surface of the claimed substrate. The claim never encompasses a **thickness** of zero, but rather claims a quantity of material located in the space (thickness) between 0 and $Z/3$ of the substrate. This is not the same as saying the thickness of a material can vary to all numbers up to and including a thickness of zero. Rather the claim recites that whatever the thickness of the substrate (some positive number, designated as "Z") at least the claimed quantity will be present in that portion of the thickness defined by the space between 0 and $Z/3$ (i.e. the top third). There is nothing unclear or improper about this language.

Claims 2-8 all depend from Claim 1 and the rejections of these claims is based on the supposed lack of clarity in Claim 1. Because Claim 1 would be sufficiently definite to one of skill in the art as written, the rejection of Claim 1 should be withdrawn. The Examiner is, therefore, respectfully requested to withdraw the rejections under 35 U.S.C. § 112, second paragraph of Claims 1-8 and to allow the claims.

III. Rejections Under 35 U.S.C. § 103

Claims 1-20 have been rejected under 35 U.S.C. § 103. Claims 1, 2-7, and 9-20 have been rejected under § 103 as unpatentable over the Roe et al. patent alone. Claims 2 and 8 have been rejected under § 103 as unpatentable over the Roe et al. patent in view of Lang (U.S. Patent 4,994,053).

A. Notes on Roe et al. Patent (U.S. 6,426,444 or 6,426,442)

The Applicants note that it is unclear exactly what patent in the name of Roe et al. is being applied in the Office Action. The Office Action cites U.S. Patent No. 6,426,442 as the patent number. However, the PTO form 1449 cites U.S. Patent 6,426,444. As the '444 is in fact issued in the name of Roe et al. and contains disclosure similar to that identified in the Office Action, the Applicants presume '442 was merely a typographical error and that the Examiner meant to apply U.S. Patent 6,426,444 in the name of Roe et al. (indeed U.S. Patent 6,426,442 is issued to another party and is very different from the disclosure discussed in the remained of the Office Action).

B. Rejections of Claims 1-20

All of the rejections of Claims 1-20 depend in whole or in part on the Roe et al. U.S. Patent 6,426,444. Applicants note, however, that Roe et al. can only serve as a reference under 35 U.S.C. § 102(e). Because the instant application was filed on June 29, 2001, subject matter that only qualifies as prior art under 35 U.S.C. § 102(e) cannot be used as the basis of a rejection under 35 U.S.C. § 103(a) if the (referenced) subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. 35 U.S.C. § 103(c).

Both the invention of the instant application and the invention of Roe et al. were subject to an obligation of assignment to the Procter & Gamble Company at the time each invention was made. See the assignment document recorded on December 1, 1997 at Reel 8833 Frame 0885 with respect to the Roe et al. patent, and the assignment document recorded on August 13, 2002 at Reel 013187 frame 0262 with respect to the instant application. Both provide evidence of both the common ownership in the Procter & Gamble Company as well as the common obligation to assign at the time each invention was made. Therefore, the subject matter of the Roe et al. patent is excluded by 35 U.S.C. § 103(c) from consideration under 35 U.S.C. § 103(a). Because all of the rejections under 35 U.S.C. § 103(a) depend on whole or in part on consideration of the Roe et al. patent, they are improper and should be withdrawn.

SUMMARY

All of the relevant rejections in the Office Action have been discussed.

No new matter has been added by this response.

In light of the discussions contained herein, Applicants respectfully request reconsideration of the rejections and their withdrawal, and that all of the claims be allowed.

Issuance of a Notice of Allowance at an early date is respectfully requested.

Respectfully submitted,

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